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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

GRAVINI, STEPHEN MICHAEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 09/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/756,788

Applicant(s)

Michael C. SCROGGIE et al.

Examiner

Stephen M. Gravini

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4-17-03
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.
- ## Disposition of Claims
- 4) ☒ Claim(s) 32-58 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 11 6) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 32-58 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The independently claimed steps of a system and method of a web site for providing purchasing incentives from multiple sources or a consumer database which can identify consumers by their e-mail addresses, wherein the consumer database is connected to the web site so as to receive consumer data from the web site are not enabled by the specification, because the specification does not discuss these system and method features such that one skilled in the art would be reasonably conveyed of inventor possession of the claimed invention. The specification merely recites vague language and general concepts but not the claimed details by the applicants. Since claims 33-37, 39-40, 45-49, 51-53, 55-56 and 59-91 depend upon claim 32, 38, 44, 50, 54, and 57 which recite the independently claimed non-enabling new matter features, those claims are also rejected as being non-enabling new matter from the independent parent claim. Furthermore, claims 32, 33, 38, 39, 44, 45, and 57 contain recitations invoking 35 U.S.C. 112, sixth paragraph, as not setting a limit on how broadly the Office may construe means-plus-function language under the rubric of reasonable interpretation (please see MPEP 2181). Those claims contain means for language which is not construed means-plus-function

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language under the rubric of reasonable interpretation, because the neither the claims nor specification provides a clear limit of patentability. Those claimed means are merely exemplified after the “for” recitation and may incorporate any function that could be taught in the prior art. In order to consider those claims in light of the prior art, examiner will assume that those claims contain enabling subject matter. It is requested that applicants specify the opportunity and obligation whether to invoke 35 USC 112, sixth paragraph for claims 32, 33, 38, 39, 44, 45, and 57. In order to consider that claim in light of the prior art, examiner will assume that those claims are enabling to those skilled in the art and contain a clear limitation under the broadest reasonable interpretation.

2. Claims 32-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independently claimed steps of a system and method of a web site for providing purchasing incentives from multiple sources or a consumer database which can identify consumers by their e-mail addresses, wherein the consumer database is connected to the web site so as to receive consumer data from the web site fail to particularly point out and distinctly claim the subject matter which applicant regards as the invention, because the claims do not provide an antecedent basis for those features. Since the claims do not provide an antecedent basis for these critical independently claimed steps, the independently claimed invention is not described in the claims such that it fails to particularly point out and distinctly

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claim the subject matter which applicant regards as the invention. Since claims 33-37, 39-40, 45-49, 51-53, 55-56 and 59-91 depend upon claim 32, 38, 44, 50, 54, and 57 which recite the independently claimed indefinite feature, those claims are also rejected as being indefinite from the independent parent claim. Furthermore, claims 32, 33, 38, 39, 44, 45, and 57 contain recitations invoking 35 U.S.C. 112, sixth paragraph, as not setting a limit on how broadly the Office may construe means-plus-function language under the rubric of reasonable interpretation (please see MPEP 2181). Those claims contain means for language which is not construed means-plus-function language under the rubric of reasonable interpretation, because the neither the claims nor specification provides a clear limit of patentability. Those claimed means are merely exemplified after the "for" recitation and may incorporate any function that could be taught in the prior art. In order to consider those claims in light of the prior art, examiner will assume that those claims contain non-indefinite subject matter. It is requested that applicants specify the opportunity and obligation whether to invoke 35 USC 112, sixth paragraph for claims 32, 33, 38, 39, 44, 45, and 57. In order to consider those claims in light of the prior art, examiner will assume that those claims are not indefinite and contain non-indefinite subject matter.

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Claim Rejections - 35 USC § 102

3. Claims 32-58 are rejected under 35 U.S.C. 102(b) as being anticipated by Jovicic et al. (US 5,855,007). Jovicic discloses a system or method comprising:

a web site for providing purchasing incentives from multiple sources (see the first sentence of the abstract whereby the internet and coupon is considered patentably equivalent to the claimed web site and incentives respectively);

a consumer purchase history database based on consumer online shopping activity (the internet coupon server in the second sentence of the abstract is considered patentably equivalent to the claimed online consumer purchase history database);

a consumer database which can identify consumers by their e-mail address, wherein said consumer database is connected to said web site so as to receive consumer data from said web site (the unique internet coupon generation process transmitting a coupon back to a user's e-mail storage in the third and fourth sentences of the abstract is considered patentably equivalent to the claimed e-mail address consumer identification for web connection to receive consumer data);
and

means for delivering purchasing incentives to consumers by e-mail (the unique internet coupon generation process transmitting a coupon back to a user's e-mail storage in the third and fourth sentences of the abstract is considered patentably equivalent to the claimed e-mail address consumer delivery). In other independent claims, the recited features including reminding consumers, specific manufacture products, e-mail database or post office, personal database, and

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targeting incentives are statements of intended use and are also anticipated by Jovicic.

Furthermore, the dependently claimed features, including the amended matter in the newly added thirty-one claims are also considered statements of intended use also anticipated by Jovicic.

Claim Rejections - 35 USC § 103

4. Claims 32-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over an obvious variation of examiner's personal experience of consumer purchasing incentive distribution provided by PerformanceBike. Since at least 1994, PerformanceBike has performed the claimed method and system of

providing purchasing incentives from multiple sources;

a consumer purchase history database based on consumer shopping activity;

a consumer database which can identify consumers by their addresses, wherein said consumer database can receive consumer data; and any one of

means for delivering purchasing incentives to consumers,

means for delivering notices to purchase a specific manufacturer's product,

transmitting purchase incentives via post office, and

means for or a method informing of new incentives or printing coupons. It is also considered old and well known that the claimed consumer profile basis, purchase history database either independently administered or of a cooperative form, and where purchase history includes data based on past purchasing activity are part of a system and method of delivering

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incentives. Official notice is taken of these old and well known claimed steps because specifically:

a consumer profile basis results in different incentives for a given consumer profile (e.g. an incentive delivery to a PerformanceBike consumer who strives to be a Tour de France competitor rather than one who desires a new tricycle for a younger family member is a key element of a consumer profile basis),

a purchase history database either independently administered or of a cooperative form results marketing mailings and where purchase history includes data based on past purchasing activity (e.g. homeowners are often targeted with offers of home mortgage refinancing, home improvements such as roofing, gutter cleaning, or window replacement based on their past purchase of a home or when a tricycle purchase results in offers of children products such as child helmets, tricycle horns, tricycle bells and the like).

The claimed providing purchasing incentives from multiple sources occur when the examiner went into a PerformanceBike retail outlet store and viewed incentive discounted products from a sales catalog source or another source such as a seasonal promotional pamphlet separate from the sales catalog. The claimed consumer purchase history database based on consumer shopping activity occurs when the examiner became a member of Team Performance which is a frequent buyer program and submitted demographic data. The claimed consumer database which can identify consumers by their addresses, wherein said consumer database is connected so as to receive consumer data is considered equivalent to the examiner submitting

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data as a Team Performance member to PerformanceBike in order to provide shipping information such that the examiner Team Performance members is identified by the member address which is connected to a PerformanceBike database such that PerformanceBike mails Team Performance members seasonal sales information on a periodic basis. The independently claimed steps including means for delivering purchasing incentives to consumers, means for delivering notices to purchase a specific manufacturer's product, transmitting purchase incentives via post office, and means for or a method informing of new incentives or printing coupons were administered by PerformanceBike through consumer purchasing incentives sale mailings which included manufacturer product coupons of products available either at the retail outlet to examiner postal mailing address. The examiner experience discussed above teaches the invention except for the claimed web site or page, online interaction, or e-mail communication. It would have been obvious to one skilled in the art to provide the claimed web site or page, online interaction, or e-mail communication since web site or page, online interaction, or e-mail communication are merely automated features of a concept that is old and well known as discussed above. Please see *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) in which the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art). It is considered that the claimed web site or page, online interaction, or e-mail communication are broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result as discussed under examiner experience as a Team

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Performance member. The motivation to combine applicants claimed invention with the services offered by PerformanceBike in order is to allow advertisers greater consumer targeting capabilities through electronic mail mediums, while transferring electronic information, which clearly shows the obviousness of the claimed invention.

Double Patenting

5. Claims 32-58 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 5,970,469 or claims 1-39 of U.S. Patent No. 6,014,634 or claims 1-10 of U.S. Patent No. 6,185,541. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claim transmitting/receiving customer information over a network ('469 patent) is an obvious variation of the application claimed e-mail, because the patented claim personal information transmission data over a network ('634 patent) is an obvious variation of the application claimed e-mail, and because the patented claim of transmitting e-mail purchase incentive because in all three cases, both perform the same function in the same manner with the same result.

Response to Amendments & Arguments

6. Applicant's arguments filed April 17, 2003 have been fully considered but they are not persuasive.

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non-enablement and indefiniteness

Applicants argue that the independently claimed recitation “a web site for providing purchasing incentives from multiple sources” is enabled from the specification because offer selection by manufactures meets the enablement requirement. Examiner considers the recited purchasing incentives (or new incentives as independently claimed) to be an incentive (or new) for a purchaser, such as a discount, rebate, or coupon. Mere offer selection from the specified storage device by manufacturers and retailers is not considered to give a purchaser an incentive to select from a variety of offers. The rejections are considered proper because the independently claimed recitation is neither enabled from the specification or definite.

Applicants argue that the independently claimed recitation “wherein the consumer database is connected to the web site so as to receive consumer data from the web site” is enabled from the specification because the administrator’s web site receives data from the consumer database. However the specification discusses that it is the database which receives data not “so as to receive consumer data from the web site” as claimed. The specification is not considered enabling or definite such that the claimed invention can be reasonably interpreted to those skilled in the art. Furthermore, the independently claimed recitation “a consumer database which can identify consumers by their e-mail addresses” was not argued and together the feature rejected supra and maintained in this Office action.

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The Office notes applicants' interpretation of the second paragraph governing indefiniteness but considers the claims to be indefinite because the claims fail to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The rejection of those claims is considered proper and maintained.

The rejection based on "means for" language is considered proper because the specification is the basis for construing how broadly the claims are reasonably interpreted. Applicants arguments stating the sixth paragraph is not a basis for rejection and the prior art should be the basis for reasonable interpretation such that the rejection under that paragraph is incorporated under the first and second paragraphs.

anticipatory rejections

One of the many references which clearly anticipate the claimed invention is discussed above as to why the invention is anticipated by the prior art.

obviousness rejections

Examiner maintains the obviousness rejection because applicants have narrowly interpreted that the claimed invention exemplified by PerformanceBike and its recent web site antedates the prior art. PerformanceBike has existed since at least the mid 1980's. Please refer to PerformanceBike.com for the history of PerformanceBike. Examiner has been a member of team Performance (a frequent buyer club patentably similar to the claimed invention) since 1994. It

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was only recently that PerformanceBike has automated the sales offered through team Performance through the use of internet, web sites and e-mails. The claimed invention is considered an automated version of purchase incentive notification sales strategies that are considered old and well known. An example of an old and well known version of the claimed invention is discussed supra under the obviousness rejection, such that automation, as claimed by the applicants, will not impart patentability under well established rulings and Office practice.

double patenting rejections

The rejections are considered proper because earlier patents from the same inventive entity or assignee claim purchase incentive for consumers using computer transmission of data including personal computers, networks, servers, customer information, and customer selections. These earlier features claimed are considered an obvious variation to the present application claimed web site consumer purchase incentive messaging.

Conclusion

7. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is "steve.gravini@uspto.gov". Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicants choose to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.** Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The Official Fax Numbers for TC-3600 are:

After-final	(703) 872-9327
Official	(703) 872-9326
Non-Official/Draft	(703) 872-9325


STEPHEN GRAVINI
PRIMARY EXAMINER

smg
July 25, 2003